

### **REMARKS**

This reply is submitted in response to the Restriction Requirement dated January 12, 2009.

Claims 1-25 are before the examiner. Claim 1 has been amended to insert that the carbon dioxide is present in a supercritical state. Claims 2-25 have been amended to delete multiple dependencies and correct typographical errors. New claims 26-48 are presented and are supported by the claims as originally filed and page 4, line 31 to page 5-21, page 7, lines 8 -21. No new matter has been added.

Please reconsider the restriction requirement and application in light of the above amendments and following remarks.

#### **Restriction Requirement**

Claims 1- 25 are pending and have been subjected to a six way restriction requirement:

- Group I claims 1-9 and 13-25 drawn to a process of preparing epoxides;
- Group II claims 1-8, 10 and 13- 25 drawn to a process of preparing aldehydes;
- Group III claims 1-8, 10 and 13-25 drawn to a process of preparing ketones;
- Group IV claims 1-8, 10 and 13-25 drawn to a process of preparing acids;
- Group V claims 11-25 drawn to a process of preparing acids from epoxides; and
- Group VI claims 11-25 drawn to a process of preparing alcohols from epoxides.

Applicant respectfully disagrees with restriction requirement. However, Applicant elects the claims of Group I claims 1-9 and 13-25 drawn to a process of preparing epoxides, with traverse. Further, Applicant elects the species of epoxyoctane, with traverse.

New claims 26-39 and 42-48 fall within Group I and new claims 40 and 41 fall within Groups V and VI.

The instant application is a US national Stage Application of a PCT Application. Therefore under MPEP § 1893.03, national stage prosecution proceeds in the same manner as for domestic applications with the exception that:... (B) Unity of Invention proceeds as under 37 CFR § 1.475.

37 CFR § 1.475 (a) states "[an] international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Further 37 CFR § 1.475 (b) states "...[an] international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; ...."

Applicant respectfully submits that claims 1-25 have unity of invention as defined in 37 CFR § 1.475 (a). Specifically the main inventive concept, *inter alia*, is the presence of the supercritical carbon dioxide. Every claim requires this aspect, therefore unity of invention is present.

Applicant further submits that claim 15, Group I and Groups V and VI are related as described in 37 CFR § 1.475 (b)(2) as product and process of using said product. Applicant notes that 37 CFR § 1.475 (c) states " [if] an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention *might* not be present." (emphasis added) 37 CFR § 1.475 (c) does not prohibit unity of invention when two classes are present, it only says it might not be present. Applicant submits that that is not the situation here.

The same inventive concept of the presence of supercritical carbon dioxide is required in all the claims, thus unity is preserved.

Additionally, as noted in the MPEP §803, “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions” (emphasis added).

Applicant respectfully submits that the search and examination of all of the claims in the application can be made substantially without burden, and certainly without serious burden, since all the claims have already been found to have unity of invention and have been searched, examined and found to be novel and inventive by the EPO acting as the Searching and Examining Authority during the PCT Chapter I and II procedures.

Further, it is also respectfully submitted that it would not require undue burden to examine all six Groups in this application, even if they had not been previously searched. Applicant respectfully submits that regardless of the classification system, the Examiner will have to search the same art, e.g. art using supercritical carbon dioxide. Thus, it is more efficient and cost effective if all are searched and examined at the same time, particularly since, as discussed above, they have already been searched and examined. Applicant respectfully submits that it would not require an undue burden for the Examiner to search and examine all the Groups. For all the above reasons, Applicant respectfully requests withdrawal of the restriction requirement.

#### Rejoinder

In the event the Examiner does not withdraw the restriction requirement, Applicant requests rejoinder of the claims under MPEP § 821.04(b) upon any future indication of allowability. Further, Applicant requests rejoinder of Groups V and VI with Group I.

Information Disclosure Statement

Applicant notes that six references were cited during the PCT phase of the instant application. They were: DE 19600709; US 5,210,336; US 4,833,260; DE 19725820; DE 19723949; and US 4, 483,996. The Examiner is encouraged to review these references.

Applicant also notes the European equivalent of the instant application is granted as EP 1 086 062 B1.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and respectfully requests notice of such.

Please charge any deficiency in fees or credit any overpayments during the entire pendency of this case to Deposit Account No. 05-1712. Please also charge any petition fees, including fees for extensions of time necessary for the pendency of this case or copendency of this application with another application at any time to Deposit Account No. 05-1712.

Respectfully submitted,

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